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MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,471

Applicant(s)

ROTHMAN ET AL.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 4-14 and 17-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

On 13 December 2000, Applicant filed the instant application, claiming priority to provisional application 60/208521, filed 1 June 2000. The application was published as PG-PUB 20020072984 on 13 June 2002.

On 12 August 2004, the Examiner issued a requirement for Election/Restriction.

On 11 February 2005, Applicant elected a first set of claims for examination, without traverse.

On 6 April 2005, the Examiner made a second requirement for Election.

On 6 May 2005, Applicant elected species I.a with traverse.

On 12 August 2005, the Examiner rejected claim 1 as anticipated by Yamada (US 6,336,100), claim 2 as unpatentable over Yamada (US 6,336,100) in view of Borgato (US 5950178), and claims 3, 15-16 as unpatentable over Yamada (US 6,336,100) in view of Ross, Jr. et al. (US 6629135).

Response to Amendment

Applicant's submission of 3 February 2006 has been entered.

Applicant amended claims 1, 2 and traversed the rejections.

Claims 1-60 are pending, of which 4-14 and 17-60 are withdrawn from consideration as directed to a nonelected invention.

Claims 1-3, 15-16 will be examined.

Response to Arguments

Applicant's arguments filed 3 February 2006 have been fully considered.

The Examiner thanks applicant for clarifying priority issues.

Objection to the claims are withdrawn in view of applicant remarks.

Previous Objections to the drawings are withdrawn in view of amendment.

Rejections under 35 USC 101 are withdrawn in view of amendment and remarks.

Arguments concerning rejections under 35 USC 102 and 103 are not persuasive.

On page 17, lines 5-8, Applicant argues, with emphasis added:

In sharp contrast to Yamada, the method of Claim 1 provides for the selling, promoting and distribution of a product online, but does not require that the ***user register*** in order to enter the online shopping system or require that the user's purchase occur online in order to take advantage of its shopping capabilities....

Claim 1 ***does not*** mention registration of a ***user***, but registration of a plurality of ***retailers***. Claim 1 ***does not*** mention ***promotion*** and ***distribution***. Claim 1, copied below for applicant's convenience, contains the following limitations:

A computer-implemented method for selling a product online, comprising:
receiving a product ***order*** from a user;
determining a geographic location of the user; and
transmitting the product order to one of the plurality of retailers, based on the geographic location of the user, wherein the user purchases the product online or offline.

Applicant appears to distort Yamada, which ***does not*** require a user to register in order to enter the online shopping system.

In operation of the online shopping system shown in FIG. 1, firstly, the online shopping service provider records member discriminating information that discriminates account settlement systems and members (customers 3) under the online shopping system from each other. Further, the online shopping service provider issues ID cards storing the member discriminating information to the members ***when customers become the members of the online shopping system***. Yamada, Col. 2, lines 57-65.

In Yamada, see also Fig. 2, step 1, "Access to online shopping service provider" by customers; ***signing*** up occurs later, only in step 2.

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In addition, Yamada is consistent with applicant's disclosures. For example:

[0067] Referring now to FIG. 7, therein is depicted an exemplary user registration process 70 according to an embodiment of the present invention. Process 70 begins at **step 71** where the user **logs into** a web site operated by the seller through seller sever 12. disclosures, page 17, lines 12-14, emphasis added.

Further, Contrary to applicant's assertions concerning his disclosures, Applicant **requires** a user to register in order to (a) obtain product availability, (b) place an order, (c) make payment, and (d) have a product delivered. An unregistered user can only request product availability (Fig. 9, step 100). The system executes Fig. 9, step 104 (*provide product availability*), **if an only if** a user is registered. Steps 1104-1116 of Fig. 11 do not create unique user identifier **34** (user database 30) and customer identifier **61** (transaction database 60). The provisional application, Fig. 9, shows likewise.

On page 17, lines 8-19, applicant argues [notes and emphasis added]:

Moreover, according to the method of Claim 1 a user may effectuate the purchase of a product either online or offline. The Applicants' specification at page 7, lines 5-15, as well as newly amended Claim 1, both indicate that a **user may order a product online through a website**, where the user can specify whether it will be an **online or an offline purchase**. [Ex. Note: appears to refer to **mode of delivery**, reference 65]

Upon receipt of an online purchase order, the network server can communicate with a third party payment processing server and the operator of the network can then ship the product to the user at an address specified by the user.

...upon receipt of an offline purchase request, the user can be directed to one or more retailers selling the product in the same geographic location as the user. The user can then pick up the product at the local distributors location, and can further **pay for the product at that location**.

Yamada does not teach or suggest the capability of **purchasing a product online or offline** in conjunction with a method for **selling a product online**. Thus, Yamada cannot anticipate Claim 1 and therefore, Applicants respectfully request that the rejection be reconsidered and withdrawn.

The Examiner respectfully notes that the claims **do not** mention a website. Also, Applicant's remarks indicate confusion concerning several other issues:

- What actions can be performed by an unregistered user [see discussion above].

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- What actions can a user [registered and unregistered] performed at an online site or at a retailer's physical location.
- What is the difference between **selling** a product online and **purchasing** [the mirror of selling] a product [online or offline].

The confusion is exacerbated by inconsistent use of several terms, including:

purchase order, purchase request, product order, product purchase, product payment and product delivery. Applicant also appears to use the qualifiers **online, offline, online purchase** and **offline purchase** to refer, generically and specifically, to various combinations of the terms.

Applicant appears to recognize this inconsistency. For example¹:

Upon receipt of an online purchase order, the network server can communicate with a third party payment processing server and the operator of the network can then ship the product to the user at **an address specified by the user**.

However, upon receipt of an offline purchase request, the user can be directed to one or more retailers selling the product in the same geographic location as the user. The user can then **pick up the product at the local distributors location**, and can further **pay for the product at that location**. [Page 17, lines 11-17, **emphasis added**].

Please note the absence of **purchase order** [online or offline] and **purchase request** [online or offline] from the claims, which refer to a **product order** [no qualifier].

On page 17, lines 20-28, Applicant argues,

Moreover, Yamada does not provide for the direct shipment of goods from a distributor/retailer to a customer. Instead, Yamada teaches away from Claim 1 by disclosing the use of multiple "home deliverers" to ship goods to customers, where in response to receiving order information the manufacturer or wholesaler delivers the good or commodity to the retailer. The retailer, in turn, passes the commodity to a first home deliverer. The first home deliverer then passes the commodity on to a second home deliverer that is closest to the place of residence of the customer. The second home deliverer then checks the delivery information and delivers the commodity to the place where the commodity should be delivered. (See Yamada at column 3, lines 26-54 and Figure 1).

The claims refer to "...transmitting the product **order** to one of the plurality of retailers..." There is no limitation concerning direct [or indirect] **shipment of goods**.

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On page 18, lines 1-10, Applicant argues,

In sharp contrast to Yamada, Claim 1 transmits the **product order** to one of a plurality of retailers, based on the geographic location of the user. Thus, a local retailer/distributor acts on the **product order** and **ships the product** directly to the consumer, or alternatively, the consumer can go directly to the retailer/distributor to pick up the **product**. (See Applicants' specification at page 20, line 13 through page 21, line 11). As a result, the method of Claim 1 involves fewer steps thereby lending itself to greater efficiency while allowing for fewer instances where mistakes in **delivery** could occur. Therefore, since Yamada teaches away from the method of Claim 1 it cannot anticipate Claim 1, and thus the Applicants respectfully request that the rejection be reconsidered and withdrawn.

Again, the claims do not contain limitations directed to number of steps, number of intermediaries, mistakes in delivery, who ships a product to what location, picking up at a retailer.

On page 18, lines 11-20, applicant argues, emphasis added:

As set forth above, Yamada does not suggest Claim 1 (from which Claim 2 depends), and in fact, teaches away from Claim 1 in that the system disclosed by Yamada requires customers to **sign up or register for entering the** online shopping system thereby allowing the customer to purchase goods online (See Yamada at column 2, lines 57-65 and Claims 1, 2, 9 and 11) as well as not providing for the direct shipment of goods from a distributor/retailer to a customer...

In response to these arguments, the Examiner again notes that the features that applicant relies upon are not in the claims. See also comments concerning Yamada and claim 1, above.

On page 18, line 21-page 19, line 9, applicant argues, emphasis added:

Borgato is directed to the sale of gems, namely diamonds, as is evidenced in the specification at column 2, lines 16-34; column 5, lines 10-15; and claims 1, 10, 16 and 18 (all independent claims) and does not disclose that products other than gems may be sold online using the system described therein. Moreover, Borgato discloses and requires the inclusion of limitations such as, for example, data relating to each stone being offered for sale, a means for forming a data matrix array, a means for price comparison and a means for a buyer to communicate a bid for particular stones. Thus, Borgato is very narrow in its focus and fundamentally different from the subject matter of Claim 2. Thus, one of skill in the art would not combine Yamada and Borgato to result in the subject matter of Claim 2, because while Borgato does make reference to the sale of diamonds, there is no proper suggestion or motivation in Borgato to cure the deficiencies of Yamada as set forth above.

¹ Applicant appears to have copied most of this material from paragraphs 39, 40 and 75.

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Moreover, even if one skilled in the art were to combine Yamada with Borgato as suggested by the Office Action, the combination would fail to provide the subject matter according to Claim 2, where a user may effectuate the purchase of a product such as a diamond either online or offline. (See Applicants' specification on page 7, lines 5-15), while delivery of the product does not require the use of multiple home deliverers. As a result, the cited references do not render obvious the subject matter according to Claim 2, and the Applicants respectfully request that the rejection be reconsidered and withdrawn.

Again, the features that applicant cites are not in the claims.

In response to applicant's argument that there is no motivation to combine Yamada and Borgato, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

On page 19, lines 10-16, applicant argues:

Claims 3 and 15-16 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,336,100 (Yamada) in view of U.S. Patent No. 6,629,135 (Ross, Jr. et al.). As set forth above, Yamada does not suggest Claim 1 (from which Claims 3 and 15-16 depend), and in fact, teaches away from Claim 1 in that the system disclosed by Yamada requires customers to sign up or *register* for entering the online shopping system thereby allowing the customer to purchase goods online (See Yamada at column 2, lines 57-65 and Claims 1, 2, 9 and 11) as well as not providing for the direct shipment of goods from a distributor/retailer to a customer...

The Examiner notes that the features that applicant cites are not in the claims.

See also comments concerning Yamada and claim 1, above.

On page 19, lines 12-16, applicant argues:

Ross Jr. et al. act as an e-commerce outsourcing system rather than acting as a method of sale from a retailer/distributor. In Ross, Jr. et al. the system provides the look and feel of a participating Host where links to particular products or product categories may be present. The look and feel of a Host is captured and stored by receiving an identification of an example page of a target host. In essence, the pages give the viewer the impression that they are viewing the pages served by the host (See Ross, Jr. et al. at column 3, lines 6-31; and claims 1,). However, the viewer is actually viewing an outsourced copy of the host page. Thus, the viewer is not dealing directly with the retailer/distributor, which is a fundamental difference from Claims 3 and 15-16 of the present invention. Thus, one of skill in the art would not combine Yamada with Ross, Jr.

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et al. because there is no proper suggestion or motivation to deal directly with the retailer/distributor or to cure the deficiencies of Yamada as set forth above.

Moreover, even if one skilled in the art were to combine Yamada with Ross, Jr. et al. as suggested by the Office Action, the combination would fail to provide the subject matter according to Claims 3 and 15-16, where a user may deal directly with a distributor/retailer, effectuate the purchase of a product such as a diamond either online or offline. (See Applicants' specification on page 7, lines 5-15), while delivery of the product does not require the use of multiple home deliverers. As a result, the cited references do not render obvious the subject matter according to Claims 3 and 15-16, and the Applicants respectfully request that the rejection be reconsidered and withdrawn.

In response to these arguments, the Examiner again notes that the features that applicant relies upon are not in the claims.

In response to applicant's argument that there is no motivation to combine Yamada and Ross, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

At several points in his remarks, applicant argues that the references fail to show certain features of applicant's invention, including features that appear to lack written description and enablement. The Examiner notes that although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

To clarify the record, and in view of applicant's comments and amendments, the Examiner finds it necessary to enter rejections under 35 USC 112.

Claim Rejections - 35 USC § 112 – first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 15-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) It is unclear how unregistered users can do any purchasing at all, either online and offline:

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view product availability (step 104, Fig. 9), since step 104 does not appear to be executable for an unregistered user;

select between offline and online delivery since

- transaction database requires customer identifier 61 for mode of delivery 65 (which indicates whether product is purchased for online or offline delivery) and customer identifier 61 [i.e., user identifier 34 of user database 30] appear to be assigned only if a user registers;

effectuate a purchase, either online or offline since

- transaction database 60 requires a customer [user] identifier 61;
- user database 30 requires a user identifier 34.

If a user is not registered (step 94), and does not wish to register (step 96), the user is sent to an unnumbered block that reads “go to steps 1104-116 [sic] of buyer location process.” Those steps do not register a user, but only determine a geographic location.

Upon return to Fig. 9, an unregistered user is permitted to view product information (step 98). If the unregistered user requests product availability (step 100), the system again checks if the user is registered (step 94, possibly 102).

If the user is not registered (step 102[?]) and does not wish to register (step 96), the user is again sent to an unnumbered block that reads “go to steps 1104-116 [sic] of buyer location process.” Again, those steps do not register a user, but only determine a geographic location.

The location may be stored as a cookie but is not entered in a user database, because the database requires a user identifier, assigned only in step 74, Fig. 7 (process 70). The identifier is used in both user and transaction databases, as appropriate for referential integrity. For applicant's convenience, relevant text from his disclosures is copied below:

[0074] The user may next query the system to determine the availability of a product in which the user is interested (step 100). The central server 12 then asks the user to submit the ***user's identifier assigned during the user registration process 70 of FIG. 7 (step 102)***². If the user is not registered, she is prompted to enter the registration process 70. If the user is registered, the process 90 continues below. [Page 20, lines 8-12, emphasis added]

Claim Rejections - 35 USC § 112 – second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the term ***or***. The term renders the claims indefinite, since it is not possible to determine the scope of the claim as requiring both items or only one of the items separated by the ***or***. For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

² The Examiner notes step 102, missing from Fig. 9, appears to correspond to the second iteration of decision block 94. See also new objection the Drawings.

As to claims 1-3 and 15-16, Applicant's inconsistent use of various terms renders the claims indefinite. In the absence of explicit definitions by applicant, to clarify the record, and for purposes of Examination, the following terms will be given their broadest reasonable interpretation³:

[product] **delivery**, the act or manner of delivering something, to convey;

[product] **order** is a request to buy, sell, deliver or receive goods or services that commits the issuer of the order to the terms specified.

[product] **payment**, the act of paying, to discharge a debt or obligation

[product] **purchase**, something obtained, especially for a price in money or its equivalent.

register (n.) a written record containing regular entries of items or details.

register (v.) to make or secure official entry of in a register.

Sell[-ing], v. to give up (property) to another for something of value (as money)

online / offline

The Examiner also notes that Applicant appears to interpret various terms differently when the terms are qualified by **online** [alone], **offline** [alone], **online or offline** [either]. The terms will also be given their broadest reasonable interpretation:⁴

Online [alone] connected to, served by or available through a [computer] system.

Offline [alone] not connected to or served by a [computer] system.

³ Definitions are from MERRIAM WEBSTER'S Collegiate Dictionary.

⁴ Definitions are from MERRIAM WEBSTER'S Collegiate Dictionary.

online or offline [either] the action may take place either online or offline, as in amendment to claim 1.

where a term appears without the above qualifiers, prior art will be interpreted to read on the claim where prior art discloses the action (either online or offline).

Drawings

The drawings are objected to because **step 102** is not shown in the drawings. This appears to be a word processing error in Fig. 9, since step 94 appears twice. The corresponding portion of the specification appears to be page 20, lines 8-12 [paragraph 0074 of PG-PUB 20020072984].

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Yamada (US 6,336,100).

As per claim 1, Yamada discloses methods for selling product(s) online:

registering a plurality of retailers. See references to virtual stores and retailers, forming contracts with retailers, as in Col. 2, lines 25-38. virtual stores 2a, are registered on server 1, as in Fig. 1.

receiving a product order from a user. See, for example, Col. 2, line 66-Col. 3, line 25.

determining a geographic location of the user. See, for example, at least Figs. Figs. 5, 6 and related text.

transmitting the product order to one of the plurality of retailers, based on the geographic location of the user. See, for example, Col. 3, lines 12-18.

Wherein the user purchases the product online or offline. See, for example, references to online shopping system, as in Col. 1, lines 18-21, Col. 2, lines 57-65.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (US 6,336,100) in view of Borgato (US 5950178).

As per claim 2, Yamada ***does not*** disclose that a product may correspond to a purchase of a diamond. Borgato discloses an online system for matching sellers and buyers of diamonds over network(s) such as the Internet. See, for example, at least Col. 2, lines 1-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamada and Borgato to disclose that a product may correspond to purchase of a diamond. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Yamada and Borgato to disclose that a product may correspond to purchase of a diamond for the obvious reason of facilitating the sale of diamonds by a retailer in geographically convenient for a customer.

Claims 3, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (US 6,336,100) in view of Ross, Jr. et al. (US 6629135).

As per claim 3, Yamada does not specifically disclose that registering is performed online. Ross discloses online registration of merchants. See, for example, at least Fig. 6, lines 8-30.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamada and Ross to disclose that registering may be performed online. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Yamada and Ross to disclose that registering may be performed online for the obvious reason that such registration may provide merchants access to their information such as marketing literature and materials and modify them as necessary.

As per claim 15, Yamada discloses that determining comprises: receiving a description of the user's geographic location from the user. See, for example, at least Col. 4, lines 50-59.

As per claim 16, Yamada discloses that description may comprises at least one of: a zip code corresponding to the user, a city corresponding to the user and a telephone area code corresponding to the user. See, for example, references to New York, and Manhattan, as in Col. 4, lines 27-40.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

09_736471_diamonds_screens_01.doc, 6 pages.

Rodney Ho, Entrepreneur Hopes His Gem Is a Cut Above the Rest --- Di-Star of Boston Serves Up 'Wow' Factor With Brand-Name Diamond --- By Rodney Ho Staff Reporter, Wall Street Journal (Europe). Brussels: Jun 2, 1998, 3 pages, downloaded from ProQuest on the Internet on 14 April 2006.

Rodney Ho, Brand-Name Diamonds: a Cut Above? Wall Street Journal (Eastern edition). New York, N.Y.: Jun 1, 1998. p. B.1, downloaded from ProQuest on the Internet on 14 April 2006.

Steve Gelsi, Staking claim on branded diamonds. Brandweek. New York: Apr 14, 1997. Vol. 38, Iss. 15; p. 16 (1 page), downloaded from ProQuest on the Internet on 14 April 2006.

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

09_736471_diamonds_screens_01.doc, shows a website implementation of applicant's invention since February 1998, well in advance of applicant's claimed priority date of 1 June 2000. The screens show, for example, online registration of retailers.

Applicant is requested to provide information relating to what features were available to customers and retailers for the period prior to 1 June 1999.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
15 April 2006

James H. Zurita
Art Unit 3625
Mark P. Adcox